

REMARKS

Claims 1-24 are pending in the present application. Claims 1, 6, 7, 9, 17 and 24 are amended herein. Support for the amendment of these claims may be found, for example, in the application and claims as filed.

Claims 1. and 24 are amended to correct the structure of formula (I) as noted in the Office Action.

Claims 6, 7, 9 and 17 are amended to address the inconsistencies noted in the Office Action.

The specification is amended at two locations to correct the chemical structures. In both instances, missing lines for bonds are inserted. Applicants respectfully submit that these are obvious errors and that there would be no doubt in the mind of a person of skill in the art as to what was intended and that the corrections made are the only correct structures. In the case of the lactone at page 10, since this structure is referred to as a lactone, and it is commonly known that a lactone is a cyclic structure, it is clear that the missing line between carbon atoms in the ring should have been present. In the case of the saligenin at page 11, since this structure is referred to as a saligenin, and it is commonly known that a saligenin includes a bond between the aromatic ring and the oxygen atom, it is clear that the missing line between the ring and the oxygen atom should have been present. Accordingly, Applicants respectfully submit that the amendments to the specification contain no new matter and are merely corrections of obvious errors.

Applicants respectfully request reconsideration and withdrawal of the rejections of Applicants' claims, and allowance of the application.

Rejection of Claims over Bardasz et al.

All of the pending claims stand rejected as obvious over Bardasz et al., U.S. 2002/0151442. Applicants respectfully traverse the rejections for at least the following reasons.

As shown both in the application as originally filed and in the Declaration of Patrick Mosier accompanying this Reply, in side-by-side comparative tests, a lubricating oil composition in accordance with the present invention provides a significant reduction in volatile phosphorus while not sacrificing wear protection, thus providing both functions of the claimed method, i.e., lubricating an internal combustion engine and improving the efficiency of the emissions control system equipped with a catalytic exhaust gas after treatment device. This result is not obtained by similar lubricating oil compositions that are outside the scope of the claimed invention, as clearly shown by the data presented and discussed in the Declaration of Patrick Mosier.

Specifically referring now to the Declaration, as shown by Example 1 (in accordance with the invention) and Comparative Example 2 in Tables 1 and 2, when a lubricating oil composition within the claims is compared in the Cameron Plint test with a lubricating oil composition having a similar average number of total carbon atoms in the R¹ and R² groups but in which all of the carbon numbers are six (as shown in Table 1), the Cameron Plint wear test results are much inferior, the wear scar being 642 microns for the Comparative Example 2 composition, as compared to the wear scar being only 301 microns for the Example 1 composition (as shown in Table 2).

Similarly, as shown by Example 1 and Comparative Example 3 in Tables 1 and 2, when a lubricating oil composition having both small and larger R¹ and R² groups but in which the average number of total carbon atoms in the R¹ and R² groups is less than the average of 10.4 carbon atoms specified (as shown in Table 1), while the wear results are somewhat worse, the phosphorus emission as measured by PEI (PEI is defined in the application) is very much worse (as shown in Table 2).

To similar effect, as shown by Example 4 (in accordance with the invention) and Comparative Example 5 in Table 3, when a lubricating oil composition having both small and larger R¹ and R² groups but in which the average number of total carbon atoms in the R¹ and R² groups is only 8.4, i.e., less than the average of 10.4 carbon atoms specified in the claims, the cam wear for the Comparative Example 5 is 21.7, which is worse than the

cam wear for the inventive Example 4, in which the average number of total carbon atoms in the R^1 and R^2 groups is 11.2, i.e., the cam wear is only 19.11. As shown in Fig. 1 of the present application, the % P retention for Example 1, which is in accordance with the claimed invention, is much better than the % P retention for comparative Example C-1, which is outside the scope of the invention. Thus, as shown by these examples, the present invention obtains both high % P retention and good wear.

Similarly, as shown by Example 4 (in accordance with the invention) and Comparative Example 6 in Table 3, when a lubricating oil composition within the claims is compared in the Sequence IV A engine test with a lubricating oil composition having a similar average number of total carbon atoms in the R^1 and R^2 groups (i.e., 12 in Comparative Example 6) but in which all of the carbon numbers are greater than four, the Sequence IVA test results are much inferior for the Comparative Example 6, the cam wear being 41.81, as compared to the cam wear being only 19.11 for the Example 4 composition. Thus, as shown by these examples, the present invention obtains both high % P retention and good wear.

Based on the results contained in the application as filed and in the presently-submitted Declaration of Patrick Mosier, Applicants respectfully submit that the presently claimed invention would not have been obvious over Bardasz et al. or any other prior art of record or of which Applicants are aware. Applicants respectfully submit that, even if the Office Action to which this Reply is responsive has stated a *prima facie* case of obviousness (which Applicants do not admit or agree), the results contained in the application as filed and in the presently-submitted Declaration of Patrick Mosier fully rebut any such *prima facie* case, and that as a result, the presently pending claims are in condition for allowance. Notice to such effect is respectfully requested.

CONCLUSION

For all these reasons, Applicants respectfully submit that the presently claimed invention fully patentably distinguishes over the prior art of record and, accordingly, the present application is in condition for allowance. Notice to such effect is requested.

In the event issues arise as a result of the filing of this paper, or remain in the prosecution of this application, Applicants request that the Examiner telephone the undersigned attorney to expedite allowance of the application.

Should a Petition for Extension of Time be necessary for the present Reply to the outstanding Office action to be timely filed (or if such a petition has been made and an additional extension is necessary) petition therefor is hereby made and, if any additional fees are required for the filing of this paper, the Commissioner is authorized to charge those fees to Deposit Account #12-2275, Docket No. 3167R-01.

Respectfully submitted,

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Date: August 21, 2008

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